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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/726,367

11/29/2000

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PD-990258

5294

20991 7590 05/29/2009
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PATENT DOCKET ADMINISTRATION
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EXAMINER

RAMAN, USHA

ART UNIT

PAPER NUMBER

2424

MAIL DATE

DELIVERY MODE

05/29/2009

PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LAWRENCE N. CHAPMAN, STEPHEN P. DULAC, and
ROBERT G. ARSENAULT

Appeal 2009-000785
Application 09/726,367
Technology Center 2600

Decided:¹ May 29, 2009

Before KENNETH W. HAIRSTON, JOSEPH F. RUGGIERO, and
KARL D. EASTHOM, *Administrative Patent Judges*.

RUGGIERO, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 from the Final Rejection of claims 1-38, which are all of the pending claims. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Brief (filed November 5, 2007), the Answer (mailed January 25, 2008), and the Reply Brief (filed March 25, 2008) for the respective details. Only those arguments actually made by Appellants have been considered in this decision. Arguments that Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Appellants' Invention

Appellants' invention relates to the network broadcast of program guide information, which describes a first set of programs and a second set of programs. The program guide information that describes the first set of programs, but not the second set of programs, is broadcast to subscribers on a first signal on a first service channel. The program guide information that describes the second set of programs is broadcast to a subset of the subscribers on a second signal on the first service channel. (*See generally* Spec. 3:9-23).

Claim 1 is illustrative of the invention and reads as follows:

1. In a network broadcasting a first signal having a first set of programs and not a second set of programs to a plurality of subscribers and a second signal having the second set of programs, a method of providing program guide information describing the second set of programs, comprising:

broadcasting first program guide information from the network, the first program guide information describing the first set of programs and not the second set of programs to the subscribers on a first service channel on the first signal; and

broadcasting second program guide information from the network, the second program guide information describing the second set of programs to a subset of the subscribers on the first service channel on the second signal, wherein a fundamental signal characteristic of the second signal differs from the fundamental signal characteristic of the first signal.

The Examiner's Rejections

The Examiner's Answer cites the following prior art references:

Chaney	US 5,867,207	Feb. 2, 1999
Hofmann	US 5,883,677	Mar. 16, 1999
Klosterman	US 6,072,983	Jun. 6, 2000
Stinebruner	US 6,133,910	Oct. 17, 2000
Eyer	US 6,401,242 B1	Jun. 4, 2002 (filed Jun. 22, 2000)
Norin	US 6,434,384 B1	Aug. 13, 2002 (filed Sep. 25, 1998)

Claims 1-3, 6, 7, 9-11, and 34-36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hofmann in view of Chaney and Norin.

Claims 4, 5, and 12-14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hofmann in view of Chaney and Norin, and further in view of Stinebruner.

Claim 8 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Hofmann in view of Chaney and Norin, and further in view of Eyer.

Claim 15 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Hofmann in view of Chaney and Norin, and further in view of Stinebruner and Eyer.

Claims 16-18, 23-28, 31, 32, 37, and 38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Klosterman in view of Chaney and Norin.

Claims 19-21, 29, and 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Klosterman in view of Chaney and Norin, and further in view of Stinebruner.

Claim 22 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Klosterman in view of Chaney and Norin, and further in view of Stinebruner and Eyer.

Claim 33 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Klosterman in view of Chaney and Norin, and further in view of Eyer.

ISSUES

The pivotal issues before us in making the determination as to whether the Examiner erred in rejecting appealed claims 1-38 under 35 U.S.C. § 103(a) are whether Appellants have demonstrated that the Examiner erred in determining the obviousness to the ordinarily skilled artisan of:

(i) combining Chaney's teaching of transmitting multiple sets of program information over the same service channel with the teachings of Hofmann or Klosterman;

- (ii) combining Norin's teaching of using signals with different characteristics to transmit multiple sets of program information with the teachings of Hofmann and Klosterman as modified by Norin; and
- (iii) additionally combining the blank channel allocation teachings of Stinebruner and the duplicative programming teachings of Eyer in separate combinations with Hofmann, Klosterman, Chaney, and Norin.

FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence:

1. Hofmann discloses (Fig. 3; col. 2, ll. 29-35) the transmission of first and second sets of program guide information on first and second signals from multiple service providers.
2. Hofmann also discloses (Figs. 9A, 9B; col. 9, ll. 13-21) that programs provided by one service provider may not be offered by another service provider.
3. Chaney discloses (col. 4, ll. 1-25, 60-65) that program information from all system transponder sources are transmitted over the same service channel (SCID).
4. Chaney also discloses (Fig. 4; col. 5, ll. 2-9) that, in addition to the master program guide (MPG), which includes information for scheduling current programs, special program guides (SPG), which include information about future programs, are also transmitted.
5. Chaney's special program guides (SPG) are disclosed (col. 5, ll. 9-10) as being "downloaded from the satellite as needed"

6. Norin discloses (col. 2, ll. 12-21) a satellite communication system in which television programming is provided to subscribers through regional broadcasting and localized television programming is provided to a subset of the subscribers through localized broadcasting.

7. Norin also discloses (Fig. 3; col. 4, ll. 8-27; col. 7, ll. 41-48) that the regional and local programming can be provided using broadcast signal beams with different characteristics.

8. Klosterman discloses (Fig. 1D; col. 4, l. 55-col. 5, l. 21) a receiver structure with a tuner to receive first and second sets of program information from distinct sources.

9. Stinebruner discloses (col. 8, ll. 27-35) a system for integrating a plurality of video sources in which a satellite content provider allocates blank channels to local programming enabling users in different areas to map local channels to the blank channels.

10. Eyer discloses (col. 6, ll. 23-29) a broadcast programming system in which a preferred source of broadcast content can be designated to avoid duplicative programming services.

PRINCIPLES OF LAW

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966) (stating that 35 U.S.C. § 103 leads to three basic factual inquiries: the scope and content of the prior art, the differences between the prior art and the claims at issue, and the

level of ordinary skill in the art). “[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). Furthermore,

“there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness” . . . [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.

KSR Int’l Co. v. Teleflex Inc., 550 U.S. 398, 418 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

Also, “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Leapfrog Enter., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007) (quoting *KSR*, 550 U.S. at 416). “One of the ways in which a patent’s subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent’s claims.” *KSR*, 550 U.S. at 419-20.

ANALYSIS

I. The rejection of claims 1-3, 6, 7, 9-11, and 34-36 based on the combination of Hofmann, Chaney, and Norin.

With respect to the Examiner’s obviousness rejection of representative independent claim 1, Appellants’ arguments in response assert a failure by the Examiner to establish a *prima facie* case of obviousness since a proper

basis for the proposed combination of references has not been established.² Appellants' arguments focus on the alleged mischaracterization by the Examiner of the disclosure of Chaney as providing for the transmission of different sets of programs on the same service channel. According to Appellants' arguments (App. Br. 13-17; Reply Br. 9-15), while admitting that Chaney is using the same service channel (SCID) to transmit program information from multiple sources such as different satellites, Chaney is in fact transmitting the same set of programs, i.e., a master program guide (MPG), which are merged on to the single channel from the multiple satellite sources.

We do not find Appellants' arguments to be persuasive. We find in Chaney ample evidence to support the Examiner's reliance (Ans. 4, 5, 26-29) upon Chaney for providing a teaching of transmitting different sets of program guide information on different signals on the same service channel. For example, Chaney discloses (FF 4) that, in addition to the transmitted master program guide (MPG), which includes the necessary information for selecting current programs, special program guides (SPG), which contain information about future programs, are also transmitted from the satellites. In particular, Chaney discloses (FF 5) that the special program guides (SPG) are "downloaded from the satellite as needed"

With the above discussion in mind, we find that Chaney discloses, as set forth in appealed claim 1, the transmission, on the same service channel, of a first set of programs (MPG), and not a second set of programs (SPG), on

² Appellants argue rejected claims 1-3, 6, 7, 9-11, and 34-36 together as a group, making particular reference solely to independent claim 1. *See* App. Br. 12-17. Accordingly, we select claim 1 as representative. *See* 37 C.F.R. § 41.37(c)(1)(vii).

a first signal. Further, it is evident that Chaney's second set of programs (SPG) are transmitted, on the same service channel, on a second signal since they are only downloaded from the satellite as they are needed.

We further find Appellants' arguments attacking the Examiner's proposed combination of Chaney with Hofmann to be unconvincing. Appellants contend (App. Br. 13, 15, 17) that a skilled artisan would not combine Chaney and Hofmann because Hofmann's teaching of transmitting different programs from different networks is a "fundamentally different" approach than Chaney's disclosure of transmitting programs on the same service channel from the same network. We do not find the disclosures of Chaney and Hofmann to be mutually exclusive of one another, nor do we find any error in the Examiner's line of reasoning (Ans. 4, 27) that finds the obviousness to the skilled artisan of applying the "same service channel" teachings of Chaney to the system of Hoffman.

Further, we also find no error in the Examiner's application (Ans. 5-6), to the combined teachings of Hofmann and Chaney, of Norin's teaching (FFs 6, 7) of using non-uniform, i.e., different signal characteristics, multiple beams to transmit different program information to a local subset of subscribers than that regionally broadcast to other subscribers. While Appellants' arguments (App. Br. 13) draw attention to the fact that Norin does not transmit program guide information, this teaching is provided by both Chaney and Hofmann.

Lastly, we refer to our earlier discussion of Chaney and note that, although the Examiner has relied upon Hofmann for a teaching of transmitting different program guide information to subscribers using different signals, such a teaching is not necessary for establishing a prima

facie case of obviousness since it is cumulative to what is already disclosed by Chaney. Further, although the inclusion of Hofmann is not necessary for a proper obviousness rejection, we find that Hofmann supplements the teachings of Chaney and Norin to establish the Examiner's prima facie case for the claims being obvious over the combination of those references. Therefore, it is our view that the Examiner did not err in concluding that the combination of Hofmann, Chaney, and Norin renders the cited claims unpatentable.

For the above reasons, since it is our opinion that the Examiner has established a prima facie case of obviousness, which has not been overcome by any convincing arguments from Appellants, the Examiner's 35 U.S.C. § 103(a) rejection of representative independent claim 1, as well as claims 2, 3, 6, 7, 9-11, and 34-36 not separately argued by Appellants, is sustained.

II. The rejection of claims 4, 5, and 12-14 based on the combination of Hofmann, Chaney, Norin, and Stinebruner.

This rejection is sustained as well. We find no error in the Examiner's application (Ans. 7) of the blank channel allocation teachings of Stinebruner (FF 9) to the combination of Hofmann, Chaney, and Norin. Appellants' response (App. Br. 17) provides no convincing arguments as to why a skilled artisan would not consider the blank channels described by Stinebruner, which are allocated for local programming, as corresponding to the claimed "surrogate" channels.

III. The rejection of claim 8 based on the combination of Hofmann, Chaney, Norin, and Eyer.

In addressing the language of appealed claim 8, the Examiner has applied (Ans. 9, 10, 30, 31) the teachings of Eyer, which are directed to the ability to select a preferred source for duplicative programming (FF 10), to the collective teachings of Hofmann, Chaney, and Norin. We find no convincing arguments from Appellants that convince us of any error in the Examiner's stated position and, accordingly, this rejection is sustained. In particular, we find no basis for Appellants' conclusion (App. Br. 17-18; Reply Br. 15-16) that the spot beam used for local programming in Norin would not have some program information that would overlap that transmitted by the primary beam used for regional programming.

IV. The rejection of claim 15 based on the combination of Hofmann, Chaney, Norin, Stinebruner, and Eyer.

This rejection is also sustained. For all of the previously discussed reasons in which we found no error in the Examiner's application of Eyer's duplicative programming teachings to the combination of Hofmann, Chaney, and Norin, we similarly find no error in the Examiner's application of Eyer's teachings to the combination of references, which includes the blank channel allocation teachings of Stinebruner.

V. The rejection of claims 16-18, 23-28, 31, 32, 37, and 38 based on the combination of Klosterman, Chaney, and Norin.

We also sustain the Examiner's obviousness rejection of representative independent claim 16, as well as claims 17, 18, 23-28, 31, 32,

37, and 38 not separately argued by Appellants.³ Representative independent claim 16 differs slightly from previously discussed independent claim 1 in that, instead of being directed to the broadcasting of program information, it is directed to a receiver for receiving broadcast signals. In addressing the language of claim 16, the Examiner has essentially substituted Klosterman for the Hofmann reference relied upon in the rejection of claim 1, and makes particular reference to Klosterman's disclosed (FF 8) receiver structure, which includes a tuner.

Appellants' arguments in response (App. Br. 18-19; Reply Br. 16-17), as with the arguments made against the rejection of claim 1, focus on the Examiner's alleged mischaracterization of the disclosure of Chaney. We again find these arguments to be unpersuasive for all of the reasons discussed *supra*. Further, as with Hofmann, we find no error in the Examiner's line of reasoning (Ans. 11-15, 28-31) that finds the obviousness to the skilled artisan of applying, to the system of Klosterman, Chaney's teaching of using the same service channel to transmit program information.

Further, as we found with Hofmann, we find that Klosterman's teaching of transmitting different program guide information to subscribers using different signals is cumulative to what is already disclosed by Chaney. Similar to our discussion *supra*, we find that Klosterman supplements the teachings of Chaney and Norin to establish the Examiner's *prima facie* case for the claims being obvious, although the inclusion of Klosterman is not necessary for a proper rejection under 35 U.S.C. § 103(a).

³ Appellants argue rejected claims 16-18, 23-28, 31, 32, 37, and 38 together as a group, making particular reference solely to independent claim 16. *See* App. Br. 18-20. Accordingly, we select claim 16 as representative. *See* 37 C.F.R. § 41.37(c)(1)(vii).

VI. The rejection of claims 19-21, 29, and 30 based on the combination of Klosterman, Chaney, Norin, and Stinebruner.

Appellants' arguments (App. Br. 19; Reply Br. 18) reiterate those made against the Examiner's addition of the blank channel allocation teachings of Stinebruner to the combination of references that included Hofmann. We found those arguments to be unpersuasive, and we find them equally unpersuasive with respect to the combination that includes Klosterman. Accordingly, the Examiner's obviousness rejection is sustained.

VII. The rejections of claim 33(based on the combination of Klosterman, Chaney, Norin, and Eyer) and claim 22 (with the further addition of Stinebruner).

The obviousness rejections of claims 22 and 33 are sustained as well. Appellants' response (App. Br. 19; Reply Br. 18-19) again relies on those arguments made against the Examiner's application of the duplicative programming teachings of Eyer and the blank channel allocation teachings of Stinebruner to Hofmann. As previously discussed, we find such arguments to be equally unpersuasive when applied to the Examiner's obviousness rejection that includes Klosterman in the proposed combination.

CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that Appellants have not shown that the Examiner erred in rejecting appealed claims 1-38 for obviousness under 35 U.S.C. § 103.

Appeal 2009-000785
Application 09/726,367

DECISION

The Examiner's 35 U.S.C. § 103 rejection of claims 1-38, all of the appealed claims, is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

babc

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